

REMARKS

Applicants amend claims 1 and 13. New claims 14-24 have been added. No new matter has been added by this amendment. Claims 5-8 have been canceled without prejudice to their further prosecution in a continuation and/or divisional application. Cancellation of claims 5-8 is unrelated to patentability. Upon entry of this amendment, claims 1-4 and 9-24 are pending in the present application.

Information Disclosure Statements

Applicants respectfully request consideration and confirmation that the references cited in the Information Disclosure Statements, filed on 10/08/03 and 9/02/05 have been considered.

Rejections under 35 U.S.C. § 103

Uemura et al. (US 5,499,153)

Claims 1-4 and 9-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Uemura et al. (US 5,499,153; hereinafter "Uemura").

According to the Office Action, Uemura teaches a slider-bonding surface of a flexure that is "incompletely, i.e., not removed at all or removed, to form a removed region". The Office Action implicitly concedes that Uemura does not disclose a region of an oxide film on a slider-bonding surface of the flexure, but argues that it would have been obvious to furnish the slider-bonding surface with a film region since the film would have enhanced adhesion.

Claim 1 (and claims depending therefrom)

To support a prima facie case for obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Uemura does not disclose or suggest each limitation recited in claim 1. For example, Uemura does not disclose or suggest a head gimbal assembly comprising an

oxide film disposed on the surface of a flexure. No such suggestion is provided by Uemura. Instead of citing appropriate references, the Office Action appears to supply film region claim elements from the Examiner's personal knowledge. However, as noted in the MPEP 2144.03, with reference to 37 CFR 1.104(d)(2):

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported**, when called for by the applicant, by an affidavit from the examiner. [Emphasis added]

Accordingly, applicants hereby request, under 37 CFR 1.104(d)(2), that the Examiner provide an affidavit to support the Examiner's contention regarding the obviousness of including a film to enhance adhesion.

Uemura further fails to disclose or suggest a film-removed region. The Office Action appears to construe "incompletely removed" as being equivalent to "not removed at all." However, an oxide film region from which no film is removed cannot constitute a film-removed region. In other words, the Examiner's position about "incompletely removed" being equivalent to not removed at all is inconsistent with a film-removed region (or an incompletely removed oxide film portion). The claim requires at least a portion of the slider-bonding surface to be free of oxide film – something that Uemura fails to disclose or suggest, either explicitly or inherently. However, if we assume for the sake of argument that it would be obvious to furnish a slider-bonding surface with a film region to enhance adhesion, it would be entirely unobvious to *then remove a portion of that film*, inasmuch as that obviousness argument is predicated on *adding* a film to mediate adhesion, not to remove the film.

Uemura further fails to provide any disclosure or suggestion to dispose a conductive adhesive resin between a film-removed region and the slider; instead Uemura merely teaches the use of a heat hardenable resin or an ultraviolet-hardenable resin as adhesives for attachment of the slider (col. 3, lines 35-37). Moreover, although Uemura teaches application of the above described adhesive resins to a recess 13 for

attachment of the slider, Uemura does not provide any basis for concluding that the recess 13 to which the adhesive resin is applied would *necessarily* (or inherently) comprise a film-removed region.

Applicants' recitation of a film-removed region in claim 1 is based on the unexpected discovery that oxide film on the surface of the flexure prevents the decrease in contact resistance between the flexure and the slider that was previously thought to occur when using conductive adhesive resin (p. 6, line 27 to p. 7, line 16). Accordingly, absent the removal of oxide film material from the adhesion region, a charged slider attached by way of conductive adhesive resin to an oxide film region of a flexure may result in electrostatic discharge, which can damage the magnetic head element on the slider.

Because Uemura fails to disclose or suggest each and every claim limitation recited in claim 1, including a film-removed region and a conductive adhesive resin disposed thereto, claim 1 and dependent claims 2-4 and 9-13 are not obvious over Uemura. Accordingly, Applicants respectfully request withdrawal of the rejection against these claims.

Dependent Claims 2-4 and 9-13

Uemura further fails to disclose or suggest other limitations recited in dependent claims 2-4 and 9-13. In particular, since Uemura does not disclose or suggest *removal* of film, it follows that Uemura does not disclose or suggest removal of the film according to the limitations set forth in dependent claims 2-4, nor does Uemura disclose or suggest a film-removed region in accordance with the limitations recited in claims 10-13. For example, the Office Action does not provide any basis for Uemura suggesting removal of film by mechanical scratching, laser irradiation or electrical discharge, nor does it provide any basis for Uemura suggesting a film-removed region: being adjacent to an oxide film, being thinner than a flexure portion not containing the film-removed region, being substantially smaller than the slider or having no perforations. The Office Action did not present a prima facie case of obviousness against claims 2-4 and 10-13, because it failed to argue or account for each and every limitation in dependent claims 2-4 and 10-13 being disclosed or suggested by Uemura. Accordingly, Applicants respectfully request withdrawal of the rejection against these claims.

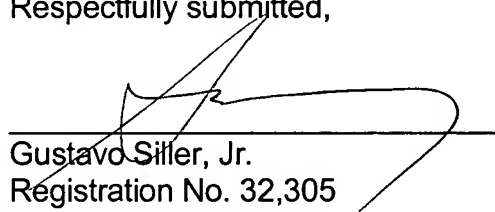
New Claims 14-24

New claim 14 depends from claim 1; it is therefore not obvious for the above reasons. New independent claim 15 (and claims 16-24 depending therefrom) are similarly drawn to a head gimbel assembly. Because Uemura fails to disclose or suggest each and every claim limitation recited in claim 15, including a film-removed region and a conductive adhesive resin disposed between the film-removed region and the slider, claim 15 and dependent claims 16-24 are not obvious over Uemura.

Conclusion

Applicants respectfully submit that the application is in condition for allowance. The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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